

## **Banks, Brenda**

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**From:** Hoffman, Michael P  
**Sent:** Monday, June 04, 2007 12:56 PM  
**To:** Banks, Brenda  
**Cc:** Gottlieb, Paul  
**Subject:** FW: W(A)-06-009 withdrawn

FYI Please update the waiver database.

-----Original Message-----

From: Lally, Brian [mailto:Brian.Lally@ch.doe.gov]  
Sent: Monday, June 04, 2007 11:58 AM  
To: Lally, Brian; Hoffman, Michael P  
Subject: W(A)-06-009 withdrawn

Michael,

Waiver No. W(A)-06-009, CH-1357 is hereby considered withdrawn. The original petition for Advanced Waiver of Patent Rights addressed the disposition of inventions arising out of DOE Instrument No. DE-FG36-05GO15185, between the University of Minnesota (UM) and DOE. More specifically, the petition addressed an assignment of rights between UM and Nu-Iron Technologies LLC, a recently formed Joint Venture between JAR Acquisition Corporation (JAR) and UM. However, since neither JAR, nor Nu-Iron is a sub-awardee under the grant, DOE determined that there is no privity of contract between DOE and Nu-Iron. Therefore, the petition for patent waiver was considered withdrawn. In conversations between DOE patent counsel and counsel for Nu-Iron and UM it was discussed that a petition for patent waiver was unnecessary in the instant case due to lack of privity between Nu-Iron and DOE. It was determined that seeking DOE's approval of the assignment from UM to Nu-Iron was the proper remedy. DOE is currently working with UM and Nu-Iron to address the assignment issues. Please let me know if you have any questions or comments.

Best Regards,

Brian

Brian Lally

Assistant Chief Counsel

Intellectual Property Law Division

U.S. Department of Energy

## Hoffman, Michael P

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Best Regards,

Brian

Brian Lally

Assistant Chief Counsel

Intellectual Property Law Division

U.S. Department of Energy

9800 S. Cass Ave.

Argonne, IL 60439

630-252-2042

630-252-2779(fax)

FAX DATE: 3/20/06

The below identified case was assigned ☐ Identified or ☒ Advanced Waiver No. W(A) 06-009  
in a telephone conversation with REDAK Katie on 3/20/06  
(Name) (Date)

Receipt Date in Field Office: 3/8/06Petitioner: Nh- Iron Technology LLCSubject: Metallic Iron Nodule TechnologyContract Number for this Waiver: DE-FA36-05 G. 0155/85☐ Currently Unknown

If contract number for this waiver is a sub, please complete the following:

Prime Contract Number: \_\_\_\_\_

Prime Contractor Name: \_\_\_\_\_

Subcontract Number: \_\_\_\_\_

Subcontractor Name: \_\_\_\_\_

S-Number (for Identified Waivers): S- \_\_\_\_\_

☐ Currently Unknown.